

No. 13333

In the
United States
Court of Appeals
for the Ninth Circuit.

PACIFIC CONTACT LABORATOR-
IES, INC., MORRIS GREEN and
LEE W. HOGGAN,

Appellants,

vs.

SOLEX LABORATORIES, INC.,

Appellee.

Appellee's Reply Brief

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Appellee's Reply Brief

I.

STATEMENT

This is primarily a patent infringement suit on a patent dealing with contact lenses applicable to the human eye.

Prior to the development of the invention disclosed in the patent, contact lenses for use on the human eye had been developed. These almost universally had a central portion overlying the cornea of the eye either in contact therewith or spaced forwardly therefrom,

and had integral scleral flanges that extended beyond the limbus (the margin between the colored iris and the white of the eye). Such integral flanges were designed to overlie the sclera (white of the eye) to hold the central or corneal portion over the cornea.

The presence of these scleral flanges made such contact lenses very difficult to fit. Also as they pressed on the sclera and covered the sclera to a large extent they tended to shut off the natural blood supply to the eye as well as deprive the eye of natural eye fluids and the supply of oxygen available from the air. Consequently, it was necessary to use in conjunction therewith a buffer solution compatible with the tissues of the patient. The difficulties involved with the use of the buffer solution are acknowledged in defendants' Ex. I (R. 257). Even then the average patient could only tolerate wearing the lenses for approximately four hours (R. 63, 64).

The patentee proposed an entirely different approach to a solution of this problem. He proposed eliminating the scleral flange entirely and manufacturing a contact lens which would cover the cornea only. In addition thereto, the patentee's lens was to have a radius of curvature slightly greater than the radius of curvature of the patient's cornea. As set forth in the patent (R. 242):

“ . . . if the radius of curvature of the cornea measures 7.8 millimeters the radius of curvature of the concave side of the lens need only be 7.9 or possibly 8.0 millimeters.”

This increase would, of course, vary slightly with various radii of curvature of the cornea of different patients.

The result is that pressure on the sclera of the eye is entirely eliminated. The sclera at all times is exposed to the atmosphere the same as in the normal eye. The use of a buffer solution is entirely eliminated and due to the clearance between the lens and the cornea, the natural eye fluids may flow between the lens and the cornea and constantly replace themselves. The remarkable part of this lens is that, although it is larger or flatter than the cornea, that it remains attached to the eye probably by capillary action and that it does not slide to the bottom of the eye and remain there. Although there may be temporary displacements from the cornea subsequent blinking of the eyelids causes the lens to re-center itself with respect to the cornea whenever such a temporary displacement occurs.

The bevelling of the inside marginal edge of the lens is not simply for the purpose of smoothing, as appellants insinuate, pages 10 and 11 of their brief. As set forth in the patent the bevel is for the purpose of facilitating the passage of the edge of the lens over the protruding limbus when the lens is temporarily displaced from its central position over the cornea. The bevelling also facilitates the entry of the tears behind the lens. It should be observed in this connection that claim 2 recites that the bevelling is on the inside edge of the lens. If the sole purpose was to round off or smooth the edges of the lens, the bevel would be placed on the outside edge of the lens where

it would be engaged by the eyelids closing over the lens in the course of blinking.

That the development of such a lens was unobvious to those skilled in the art is demonstrated by the fact that when the patentee submitted his proposal to an eye specialist, Maurice W. Nugent, Nugent

“told him that it was a wonderful theory but I didn’t think it would work, and Mr. Tuohy then informed me that he was wearing the lenses” (R. 209, 210).

It is also demonstrated by the fact that the Examiner of the Tuohy application in the Patent Office also expressed doubt as to the operability of this lens until a demonstration was made on an Associate Examiner (R. 81 to 83). That the lens has subsequently been favorably received by the profession and the trade generally, see Ex. 7, a scrapbook kept by the patentee of publicity pertaining to the patented lens. The United States Government itself, after thorough investigation, has purchased these lenses (R. 79).

The defendant Green became acquainted with the existence of the patented lenses and became a customer of the plaintiff (R. 83). He was fitted with these lenses and took training from the plaintiff in the fitting of these lenses (R. 84). He signed a request for the plaintiff’s manual, Ex. 9, and in response thereto he was supplied with Ex. 8. He engaged the defendant Hoggan, a former employee of the plaintiff (R. 85) and proceeded to infringe the patent in suit.

The plaintiff adopted and used in connection with its lenses the terms “Corneal” and “Tuohy Corneal” (R. 87). The defendant Green, in exploiting his infringing lenses, advertises that his lenses are “Cornea” lenses (R. 113, see Ex. 12).

The appellants in their specification of errors (appellants’ brief, page 5) do not dispute the question of infringement, if appellee’s patent is valid. Their attack is directed primarily against the validity of the patent. They challenge the validity of the patent on three grounds:

- 1) Lack of patentable invention (appellants’ brief, p. 9).
- 2) The claims do not define “the alleged invention in the clear and definite manner required by the statute” (appellants’ brief, p. 11).
- 3) That the invention resided in the method of fitting and not in the article (appellants’ brief, p. 16).

II.

THE QUESTION OF INVENTION IS A QUESTION OF FACT AND IS NOT TO BE DISTURBED ON APPEAL IF SUPPORTED BY ANY SUBSTANTIAL EVIDENCE OR UNLESS IT IS CLEARLY ERRONEOUS, RULE 52(a).

This Court has stated many times in patent cases that the question of invention is a question of fact and that the Trial Court's finding of invention will not be disturbed upon appeal if supported by any substantial evidence, unless it is clearly erroneous.

Ralph N. Brodie v. Hydraulic Press, 151 F. (2d) 91 (C.A. 9);

Maulsby v. Conzevoy, 161 F. (2d) 165 (C.A. 9);

Refrigerating Engineering v. York, 168 F. (2d) (C. A. 9) 896;

Helbush v. Finkle, 170 F. (2d) (C.A. 9);

Faulkner v. Gibbs, 170 F. (2d) 34 (C.A. 9), affirmed 338 U. S. 267;

Lane-Wells v. Johnson, 181 F. (2d) 707 (C.A. 9).

In the present case the Trial Court has found (R. 17):

“12. The patent in suit is for an invention that is a definite advance in the art of contact lenses.”

The Trial Court also found (R. 17):

“15. The patented lens is not anticipated by any prior patent or printed publication or any

prior knowledge or public use of any prior invention pleaded in the defendants' answer, including

'Contact lenses' by Theo E. Obrig, pp. 370, 373, 1942 edition; pp. 129-130, 1947 edition.

Obrig Laboratories.

Dr. Morris Green.

U. S. Letters Patent No. 722,059, Volle, March 3, 1903.

U. S. Letters Pat. No. 2,000,768, Lincke, May 7, 1937.

.
'The Design of Contact Lenses,' by Vincent Hill, published in The Optician May 23, 1947, pp. 335, 336, 337, and 341."

Despite this finding the appellants assert at page 9 of their brief

"Corneal lens structure as described by the Tuohy patent claims was old, as shown by the description of the Kalt lens in the Obrig book; by the lenses made by Dr. Green in 1946 (Ex. 3, R. 149); by the description of the 'Gualdi' lens in the publication 'The Optician' (Ex. I, R. 255); and by the corneal portions of the contact lens of the Lincke patent 2,000,768 (Ex. G, R. 248), and the Volle patent 722,059 (Ex. H; R. 251)."

All of these references are file wrapper references cited by the Examiner during the course of the prosecution of the application for the patent in suit before the Patent Office. They have consequently been already twice reviewed; once by the Examiner and once by the District Court. In what manner the Examiner

was in error or the District Court was in error in holding that these references did not anticipate, the appellants do not set forth in their brief. They do make some discussion of the description of the Kalt lens described in the Obrig book and purport to quote therefrom on page 7 of their brief. However, their quotation from the Obrig book deletes the last and highly significant statement. The entire quotation reads as follows and the matter deleted by the appellant is underscored:

“E. Kalt

“About the same time that August Muller was experimenting with contact lenses, an optician, E. Kalt, independently carried on an investigation of his own. He ground some small lenses to correct keratoconus which had no scleral band, and rested at the edge of the cornea. They were designed to exert some pressure on the apex of the conus in an attempt to reduce the ecstasia as well as to correct the visual error. As might be expected, they were unsuccessful.”

It requires no citation of authority to the effect that a mere unsuccessful abandoned experiment will not anticipate a validly issued patent. Manifestly, a printed description of an unsuccessful abandoned experiment is of no greater anticipatory effect than the abandoned experiment itself.

The situation here is somewhat similar to that in *Balaban et al v. Polyfoto Corporation*, 47 F. Supp. 472:

“The process described in the Burrows & Colton publication is open to the same distinction as pointed out in respect of the Wilson and Snapp patents. In addition to that, as the Burrows & Colton disclosure is merely a publication, it is discredited under the rule that an inoperative device (and the evidence shows that the device was inoperative) disclosed in a printed publication cannot anticipate a later operative device. *Permutit Co. v. Harvey Laundry Co.*, 279 F. 713, 719 (C. C. A. 2).”

See also, *United Chromium, Incorporated v. Great Lakes Plating & Japanning Co.*, 43 U.S.P.Q. 439:

“THE SARGENT ARTICLE AS AN ANTICIPATION

“Sargent taught that trivalent chromium of chromic sulphate was the essential thing. Sargent did not teach that acid radicals were the important things that needed to be controlled. Accordingly, he did not teach that the radicals function as the catalyst or that their concentration should bear ratio to the chromic acid concentration within defined limits. Sargent’s suggestions as to the regulation of the bath for continuous operation were erroneous. He did not know or teach that the catalyst acid radicals and their ratio to the chromic acid concentration were the critical elements.

“An important consideration in connection with the Sargent article is that qualified men who followed Sargent’s teachings failed.

“The Court concludes that the Sargent article did not anticipate the disclosure in the bath patent.”

In the present case it is obvious from the disclosure in the Obrig book itself that the Kalt lenses were unsuccessful. One reason that they were unsuccessful is that they were designed for the particular purpose of correcting keratoconus, an unusual situation. Secondly, they were unsuccessful because they “*rested at the edge of the cornea.*” This is directly opposed to the teachings of the patent in suit which specify that the lens shall be flatter than the cornea so that there will be a space between the edge of the lens and the edge of the cornea or limbus. This space prevents the patented lens from *resting* “at the edge of the cornea”.

There is, therefore, no error on the part of the Examiner or on the part of the District Court in throwing out the Obrig book as an anticipation.

The other references referred to on page 9 of appellants' brief are not even discussed. The Gualdi lens referred to in Ex. I (R. 255) makes no disclosure of eliminating the scleral flange. Ex. I describes the Gualdi lens as one

“which has one continuous curve, thus fitting on the eyeball very much as an upturned cup fits on an upturned saucer.”

At R. 256, Gualdi's lens is described as eliminating “the scleral *radius.*” Apparently therefore Gualdi had

a scleral flange but either made it flat without a radius instead of with a radius, or made it of the same radius as that of the portion that overlay the cornea. Certainly, there is no clear disclosure in Ex. I of how to make the patentee's lens with all of its characteristic limitations. In fact, this exhibit is but a discussion of the difficulties involved in making scleral-type contact lenses, which difficulties are eliminated by the invention of the patent in suit.

The Lincke Patent No. 2,000,768 (R. 248) is but a disclosure of a method of making the scleral type contact lenses having flanges integral with the corneal surface *c* referred to as "peripheral sclerotic part *d*." (R. 250, colum 2, line 13.) There is no disclosure in this patent of eliminating or omitting the scleral flange.

The Volle Patent No. 722,059 (R. 251) likewise does not disclose eliminating the scleral flange. The drawing clearly shows the lens extending over the entire front portion of the eye including the sclera and extending beneath the eyelids.

There is likewise no disclosure in any of the references of making the lens of greater radius of curvature than that of the cornea.

The appellants seem to rather reluctantly concede on page 3 of their brief that the lenses disclosed in the Volle patent and in the Lincke patent both include the integral scleral flanges that overlie the sclera. These flanges, the patentee Tuohy, intentionally omits to

gain the advantages of (1) leaving the sclera exposed to atmosphere, (2) avoiding the attendant pressure which retards the blood supply, and (3) obtaining the distribution of tears through contact of the lids with the sclera.

It is also contended by the appellants that despite the defendant Green's interest in the plaintiff's lenses, his solicitation of the plaintiff's manual, and his receipt of training in the fitting of the lenses that nevertheless the defendant Green made the same type of lens in 1946, by trimming the scleral flanges from some scleral-type lenses (appellants' brief, page 3). The Trial Court must have rejected his testimony to this effect and found to the contrary in finding 15 (R. 17). Proof of such prior invention by the defendant Green beyond a reasonable doubt was required.

Hoeltke v. Kemp, 80 F. (2d) 912 (C.C.A. 4);
Adamson v. Gilliland, 242 U. S. 350.

The impossibility of Green's story that he merely took some conventional scleral-type lenses and merely trimmed off their scleral flanges is established by the testimony of Tuohy (R. 227-229) wherein he asserts that lenses so prepared could not be seen through by the patient without further alteration.

The appellants assert at page 11 of their brief that the patentee, Tuohy, has failed to make a patentable invention under the "flash of genius" decision of *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. 84. However, in the concurring opinion of Mr.

Justice Douglas and Mr. Justice Black in *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147, it is stated:

“ . . . An invention need not be as startling as an atomic bomb to be patentable. But it has to be of such quality and distinction that masters of the scientific field in which it falls will recognize it as an advance.”

That the patentee's invention meets this requirement is established by the recognition given thereto in the scrapbook, Ex. 7. The Trial Court, in its memorandum opinion (R. 11), said:

“ . . . I realize that the patent is limited in its scope but I feel that the patent involved was and is a definite advance in the art of contact lenses.”

Finding 12 (R. 17) is made to this effect. This finding is well supported by the evidence and is very far from being “clearly erroneous”.

Even the defendants, themselves, in their instruction manual, Ex. 13, make an acknowledgement that the Tuohy lens was a definite advance in the art. The following is quoted therefrom:

“In 1948 Dr. Morris W. Nugent, M.D., of Los Angeles, who had acted as ophthalmologic consultant in the development and trial of corneal lenses which were supplied to him by Mr. Kevin Tuohy of the Solex Laboratories, presented his first report on his experiences with corneal lenses. The results were so impressive and the publicity

given was so favorable that a great interest was immediately aroused throughout the country, as well as in foreign lands, for further trial. . . .

“In a second report given by Dr. Nugent in 1949, the larger series of patients who have been successfully fitted has definitely established the corneal contact lens as an invaluable adjunct in the correction of defective vision.”

III.

THE CONTENTIONS OF THE APPELLANTS THAT THE CLAIMS OF THE PATENT IN SUIT FAIL TO DESCRIBE THE ALLEGED INVENTION IN THE CLEAR AND DEFINITE MANNER REQUIRED BY R. S. 4888 AND THAT THE INVENTION SHOULD HAVE BEEN PROTECTED BY A METHOD PATENT RATHER THAN AN ARTICLE PATENT CANNOT BE RAISED FOR THE FIRST TIME ON APPEAL.

The defense that the claims are not sufficiently definite as presented at pages 11 *et seq.* of appellants' brief and the contention that Tuohy's invention should have been protected by a method patent and not an article patent, were not pleaded in the defendants' answer. These issues were not raised during the trial and no testimony concerning them was taken during the trial. The contentions were not asserted in briefing the case before the Lower Court and no decision or ruling was made thereon in the Lower Court's memorandum opinion. Likewise, no findings were made on either of these contentions.

These contentions were first injected into the case on the defendants' motion for a new trial (R. 24). The motion for a new trial was denied (R. 39).

Rule 8(c) of the *Federal Rules of Civil Procedure* provides:

“In pleading to a preceding pleading, a party shall set forth affirmatively . . . any other matter constituting an avoidance or affirmative defense.”

Rule 12(h) of the *Federal Rules of Civil Procedure* provides:

“A party waives all defenses and objections which he does not present either by motion as hereinbefore provided or, if he has made no motion, in his answer or reply, . . .” (With certain exceptions not applicable here.)

It is well settled that a contention or argument which is not presented before the Trial Court cannot be raised for the first time on appeal. *Johns & Johns Printing Company v. Paull-Pioneer Music Corporation*, 102 F. (2d) 282 (C.C.A. 8):

“The contention that the plaintiff's copyright on the song ‘The Sidewalks of New York’ is invalid and void was not raised in the lower court. The plaintiff's ownership of the copyright was admitted by stipulation. It is, therefore, too late to raise that question in this court. *Hall v. Aetna Life Ins. Co.*, 8 Cir., 36 F. 2d 171; *Brown v. Gurney*, 201 U. S. 184.”

The Patent and Licensing Corporation v. Olsen, 188 F. (2d) 522, (C.A. 2):

“Olsen’s argument that the patents in question are saved from assignment by the exception to clause 1 (b) which makes it unnecessary for Olsen to assign inventions on improvements of patents licensed under clause 2 (a) was not raised in the trial court. It cannot be raised here.”

Cold Metal Process Co. v. McLouth Steel Corp., 170 F. (2d) 369, (C.A. 6):

“McLouth urges that the Agreement was unlawful and unenforceable (1) because of a provision therein which, it asserts, required it as licensee, to purchase only from the patentee unpatented parts of the assembly claimed to be covered by the patent and (2) because of a provision which, it asserts, prohibited it from selling or alienating the patented mills to which it claimed it had absolute title.

“These considerations were not, as Cold Metal points out, brought to the attention of the District Court and were not advanced as grounds for the appeal, other than under the general point that the license agreements were valid. The appellant cannot be permitted to raise for the first time on appeal questions which if raised below might have been met by the other side. *Ford Motor Co. v. Chas. A. Myers*, 64 F. 2d 942, 944 (C.C.A. 6).”

Container Patents Corp. v. Stant, 143 F. (2d) 170 (C.A. 7):

“As to this defense, it is sufficient to say that it was not presented to the court below and it cannot be presented here for the first time. *New York Life Ins. Co. v. Calhoun*, 114 F. 2d 526, 543, *Ramming Real Estate Co. v. United States*, 112 F. 2d 892; *Hutchinson v. Fidelity Investment Association*, 106 F. 2d 431, 436; *Towle v. Pullen*, 238 F. 107, 111. The only places in the record where the point is mentioned are the opening statement of counsel, the objections to the master’s report (which could not have considered the issue at all), and the statement of point to be urged on appeal. None of these references seems to us to have adequately presented the issue to the trial court.”

Brown v. Warner, 173 F. (2d) 162 (C.A. 5):

“We agree with appellee that the defense of illegality, unsupported as it is by either pleading or proof, was not made out below, and may not be urged here.”

The appellants in arguing these contentions in effect are proceeding as if the motion for new trial wherein they were first raised had been granted. Had the motion for a new trial been granted, these contentions would have been thoroughly litigated in the Lower Court and a ruling as well as findings thereon would have been made from which an appeal might be taken. However, the motion for new trial was denied, and as these questions were not tendered during the trial, it is unfair to the appellees to now be confronted with a contention on which they have had no oppor-

tunity to be heard in the Trial Court, and on which they have had no opportunity to present evidence. It is respectfully submitted that in view of the state of the record it is now too late for the appellants to assert these contentions here.

IV.

THE CLAIMS OF THE PATENT IN SUIT ARE NOT INDEFINITE

If it is proper for this Court to consider appellants' present contention that the claims are indefinite in spite of the fact that this contention was not raised in the court below, except in defendants' motion for a new trial, it is respectfully submitted that the claims are sufficiently definite to comply with the terms of the statute. *H. H. Robertson Co. v. Klauer Manufacturing Company*, 98 F. (2d) 150 (C.C.A. 8):

“The argument is that the patent does not define ‘substantial’ or ‘substantial space’ so that such space could be ascertained therefrom by one skilled in the art. While the statute (35 U.S.C.A., Section 33) requires ‘such full, clear, concise, and exact terms as to enable any person skilled in the art . . . to make, construct, compound and use the same’ yet ‘A limited use of terms of effect or result, which accurately define the essential qualities of a product to one skilled in the art, may in some instances be permissible and even desirable’ (*General Elec. Co. v. Wabash Appliance Corp.*, 304 U. S. 364). Here the space is hardly capable of

mathematical determination and definition since that space is largely dependent upon the relativity of the education pipe, the storm band and the cap and such relativity must be applied to ventilators of varying size. None the less, the drawing (Fig. 2) and the specifications indicate the thought by the lines 21, 41 and 42 and the specifications (p. 2, ll. 120-128) further explain the thought by relative measurements as follows:

‘In practice a highly efficient ventilator has been made in which the storm band 13 has a diameter equal to 1.92 of the diameter of the eduction pipe, and the lower edge or rim of the cap member has a diameter equal to 1.33 of the diameter of the eduction pipe and is separated from the latter by a distance which is equal to .584 of the diameter of the eduction pipe.

‘While it may be preferred to maintain this relation between the size of the storm band and cap member to the eduction pipe, it is not desired to limit the invention in this respect.’

“Such disclosures are sufficient.”

In comparison with the facts of the above case, the claims of the patent in suit specify that the lens has

“a radius of curvature on its concave side slightly greater than the radius of curvature of the cornea to which it is applied so that radially from the center of the lens there will be a small but gradually increasing clearance for the entry of natural eye fluids between the lens and the cornea.”

An example of what is meant by the term "slightly" is given in the specification (R. 242) :

"These clearances need not be great and, for example, if the radius of curvature of the cornea measures 7.8 millimeters the radius of curvature of the concave side of the lens need only be 7.9 or possibly 8.0 millimeters."

In a situation such as is presented in the present case, it is impossible to define the relationship between the curvature on the back of the lens and the curvature of the cornea with mathematical certainty. The radius of curvature of the cornea with different individuals varies. Even with the same individual, the radius of curvature on a given eye may be different when measured on vertical and horizontal meridians. Thus, in the order sent by the witness Lionel Lewis to the defendants to have filled the prescription for the right eye had a radius of curvature (when converted to diopters) of 45 measured on the vertical meridian and 47.79 when measured on the horizontal meridian. In the case of the left eye, the radius of curvature in diopters measured vertically was 45.00 and when measured horizontally 48.00 (R. 51, 52). This was an actual prescription of a patient (R. 54). Under such circumstances, it is impossible to set up an exact mathematical relationship. Variations in the human eye are too great. But the patent does teach that a fundamental and necessary characteristic of the lens is that it shall have a radius of curvature greater than that of the cornea but only a slight amount greater. The lens is not satisfactory

when the radius of curvature of the lens is exactly equal to that of the cornea and it likewise is not satisfactory when the lens has a radius of curvature smaller than that of the cornea (R. 214).

35 U.S.C.A., Sec. 33, while it requires that the applicant “particularly point out and distinctly claim,” does not demand the impossible of the inventor. *Chicago Pneumatic Tool Company v. Hughes Tool Co.*, 97 F. (2d) 945 (C.A. 10):

“There is one further contention in respect to infringement. It relates to the width and depth of the spaces between the rows of teeth. The patent teaches in language too clear for doubt that the spaces shall be wide and deep in order to provide ample clearance. There was no necessity for such an arrangement when pyramidal teeth were in use; but it is essential with long, narrow, chisel-shaped, deep penetrating teeth. The accused assembly discloses wide and deep spacing with ample clearance, which comes well within the coverage of the patent.

“The patent is challenged on the ground of generality for failure to furnish a yardstick with which to determine the meaning of ‘long,’ ‘narrow’ or ‘thin’ teeth. The contention does not require extended discussion. It is difficult, if not impossible, to state in general terms an abstract rule by which to test objectionable indefiniteness or generality in a patent. Each case must be determined in large measure by its own facts. This patent is in a well known and crowded art; and the speci-

fications and drawings throw significant light upon the meaning with which the words are used. When the prior art, the specifications, and the drawings are taken into consideration in connection with the claims, the patent is not open to the objection of being too indefinite or general to disclose how the invention may be put to use and how infringement may be avoided. *Eibel Process Co. v. Minnesota and Ontario Paper Co.*, 261 U. S. 45; *Vacuum Cleaner Co. v. Innovation Electric Co.*, 239 F. 543.”

Paul E. Hawkinson Co. v. Wilcoxon, 149 F. (2d) 471 (C.A. 6):

“The District Court held that the claims in issue, to-wit, Claim #1 of the apparatus patent and Claims 1 and 6 of the method patent were invalid because Hawkinson did not ‘particularly point out and distinctly claim the part, improvement or combination, which he claims as his invention. . . .’ See Title 35, Ch. 2, Sec. 33 U.S.C.A. We cannot agree with this conclusion. The claims of a patent are always to be interpreted in the light of its specifications and drawings. This canon of construction is as old as the patent law itself and finds its latest pronouncement in *Schriber Co. v. Cleveland Trust Co.*, 311 U. S. 211, 217 . . .

“In determining the sufficiency of these patents the real test is, whether the disclosures in the specifications and claims make the inventions clear to a mechanic skilled in the art of tire retreading so that he could construct the apparatus

and practice the method. *Eibel Co. v. Paper Co.*, 261 U. S. 45, 65. That this was done is conclusively shown by the tremendous success of the patents, not only in this country, but throughout the British Empire.

“As indicated at the outset, we have not been aided in our examination of the record either by brief or by argument of counsel for appellee, but we find nothing that indicates a fatal lack of compliance with Title 35, Ch. 2, Sec. 33 U.S.C.A. The presumptions of validity arising from the grants are not negatived. We are not authorized to strike down a patent for uncertainty and indefiniteness where a reasonable construction of the specifications and claims will protect the invention. *Cleveland Automatic Mech. Co. v. Natl. Acme Co.*, 52 F. 2d 769, 771 (C.C.A. 6). Laying to one side any other construction, we are reasonably satisfied that the patents here involved are sufficiently described and claimed.”

The claims of the patent in suit, of necessity, define the article with relation to the cornea of the wearer. This is a variable. It has been held, however, that it is proper to define a structure with relation to parts of the human body, see *Ex parte Jones*, 84 U.S.P.Q. 24, a decision of the Board of Appeals of the United States Patent Office:

“ . . . The claims were rejected on the grounds that they are deemed informal and indefinite. The basis for this position is that the claims recite the relation of many of the parts to each other through

their relation to the patient's head, neck, face, or body . . . We have examined the claims with care and we notice that it is sufficient to define the relation of the various parts if it be assumed that the head and neck of a human being defines a line passing centrally through the head and neck. With this line or axis established for reference, the location of the various parts of applicant's clamps referred to in the claims may be established. This mode of definition is not as convenient to follow as one which is confined to the geometry of the clamp itself. However, it has long been the practice in the Patent Office, as will be seen by reference to the patents called to our attention by appellant, to permit devices for application to anatomy to be referred to normal anatomy to assist in defining the orientation of the parts. We cannot say that this is improper. Admittedly, directions and distances are not precisely determined in this matter (*sic*, probably manner), but this art does not ordinarily require the same precision as the machine tool art for example."

Here, the patentee has but followed well-established Patent Office practice in defining his lens by orienting it with respect to the cornea to which it is to be applied.

V.

THE INVENTION HERE RESIDED IN THE ARTICLE AND NOT IN THE METHOD OF FITTING.

The case of *Nestle-LeMur Company v. Eugene, Ltd.*, 55 F. (2d) 854, relied upon by appellants (appellants' brief, p. 17) is not in point.

Assuming for purposes of argument that the appellants can now raise the question for the first time on appeal that the Tuohy invention should have been patented as a method patent rather than an article patent, it is respectfully submitted that the invention resided in the article and not in the method and that the patent was properly issued.

As above pointed out, the Tuohy lens is a new and different article of manufacture from any similar article of manufacture heretofore devised. It differs from an ordinary watch crystal in that it has an optical correction ground thereon to correct for the visual deficiency of the wearer. It has a diameter smaller than the limbus but larger than the maximum iris opening of the wearer. In this respect it differed from all contact lenses having scleral flanges. It differed from the Kalt lens described in the Obrig book in that, instead of resting "at the edge of the cornea" it was flatter than the cornea so that its margins adjacent the edge of the cornea were spaced therefrom by the clearance referred to in the claims. These fundamental differences in the characteristics of the Tuohy lens

make it a success as contrasted with the prior scleral-type lenses and as contrasted with the "unsuccessful" Kalt lens. There was here a new article of manufacture and the invention resided in discovering that a combination of these characteristics produced a successful contact lens.

Defendants-appellants contend at pages 16 *et seq.* of their brief that the invention should have been patented as a method patent and not as an article patent. What the method would be, or how it would be defined, defendants-appellants do not undertake to assert. In fact, at the top of page 17 of their brief they deny that there is any novelty in the method of fitting the corneal lens upon an eye.

Appellants assert that the case of *Nestle-LeMur Company v. Eugene, supra*, supports their position. In that case,

" . . . The patentee is said to have discovered that, since the hair is coarser and more abundant near the roots, that portion requires heating for a longer period than nearer the tips, where it is finer and more easily injured by excessive heat."

The invention of the patentee in that case, if any, therefore resided in the method of permanent waving which consisted of applying the heat for a longer period of time to the hair near the roots than near the tips.

Usually, a method may be performed by a number of different pieces or types of apparatus. The per-

formance of the method is generally independent of the particular apparatus used to perform it. For example, in the *Nestle-LeMur* case, the heating of the hair near the roots for a longer period of time than near the tips could have been performed by any one of a large number of possible heaters. Even a sad iron-type of hair curler could have been applied for a longer period of time to the hair adjacent to the roots and a second sad iron heater could have been applied to the hair near the tips for a shorter period of time. Steam heaters could have been employed and various other pieces of apparatus could likewise have been used to carry out the method. The method of heating the hair near the roots for a longer period of time than near the tips was independent of the specific apparatus employed. The patentee, Suter, however, instead of recognizing that the invention, if any, resided in the method undertook to patent a particular form of electric heating apparatus for carrying out the method. In so doing he merely

“duplicated the electric stoves or heaters in common use (see patents to Grosert and Unger, No. 1,103,506, and to Kremer, No. 1,164,102), and connected the electric circuit in parallel to the resistance or heating coils, so that by the operation of a switch the current to the upper or outer heater could be connected or disconnected at will.”

The Court held, and properly so, that there was no invention involved in merely duplicating the well-known heaters and connecting them to a common

switch, and that the invention, if any, resided in the method rather than in the apparatus.

In contrast with the *Nestle-LeMur* case, there is here no invention in any method. The method of applying the lens to the eye or its removal therefrom is the same method as the method employed in prior contact lenses except that the use of the buffer solution is omitted. The method of measuring the cornea of the eye is acknowledged in the patent itself to be old, see R. 242, column 4, wherein it is stated:

“The corneal portion of the eye can then be measured both horizontally and vertically by any conventional measuring instrument used for this purpose.”

The prescription of the wearer “can be determined in the usual manner.”

The novelty here, therefore, did not reside in the method of refracting the patient's eyes to determine his prescription or the method of measuring the cornea or in the method of applying and removing the lens. Likewise, it did not reside in the method of manufacturing the lens. The lens can be ground in any one of a number of conventional manners.

The invention here did not reside in a method as in the *Nestle-LeMur* case, but resided in the article which was different from all prior known contact lenses. This article was different when properly oriented and measured with respect to the eye to which it was ultimately to be applied. The *Nestle-LeMur* case is consequently not in point.

VI.

**THE AWARD OF ATTORNEY'S FEES IS PROPER
AND SHOULD BE INCREASED BY THIS
COURT IN DEFENDING THIS APPEAL.**

The award of attorney's fees is discretionary with the Trial Court. In the present case the Trial Court, in its memorandum opinion, stated:

“Counsel for the defendant appears critical of the court's inquiry relative to the matter of attorney's fees. He must have been aware of the fact that if the court held the patent valid, the court would of necessity have to hold that the infringement was both deliberate and wilful, and I so find.” (R. 12.)

Obviously, this is true. The defendants infringed after the Defendant Green and the Defendant Hoggan learned all they could from the plaintiff as to the construction, fitting, and general know-how attendant the most advantageous use of the plaintiff's lenses. When the defendants undertook to infringe they advertised in a manner unethical in ophthalmological circles, and, in so doing, advertised their lenses using the terms “Cornea” and “New Cornea”.

In *Dubil v. Camp*, 184 F. 2d 899, C. A. 9, the same case referred to by appellants in their brief, this court said:

“It is not the duty of the reviewing court to interfere with the exercise of the discretionary power confided to the trial courts by Congress to

award attorney's fees in proper cases except where there is an abuse of discretion amounting to caprice or an erroneous conception of law on the part of the trial judge."

No such showing of an abuse of discretion is made by the appellants here.

The allowance of attorney's fees by the Trial Court is gratifying but hardly adequate to reimburse the plaintiff in this suit, and it is certainly not adequate to reimburse the plaintiff in defending this appeal. Consequently, this Court is requested to make its own allowance of attorney's fees for the defense of this appeal.

VII.

THERE WAS NO ABUSE OF DISCRETION IN REFUSING TO GRANT DEFENDANT'S MOTION FOR A NEW TRIAL.

Appellants, in their brief, make no showing amounting to an abuse of discretion on the part of the trial court in refusing to grant defendant's motion for a new trial. The appellants, in such motion, made no showing of any facts from which the court may infer reasonable diligence. In *Marshall's U. S. Auto Supply v. Cashman*, 111 F. (2d) 140, C. A. 10, the court said:

“A motion for new trial on the ground of newly discovered evidence must show that the evidence was discovered since the trial; *must show facts from which the court may infer reasonable diligence on the part of the movant*; must show that the evidence is not merely cumulative or impeaching; must show that it is material; and must show that it is of such character that on a new trial such evidence will probably produce a different result. *Praisament v. United States*, 5 Cir., 96 F. (2d) 865.”

Where there is a want of diligence in discovering any evidence, a new trial will be denied. *Aladdin Manufacturing Co. v. Mantel Lamp Co. of America*, (C.A. 7) 116 F. (2d) 708.

As to the reference made to The Ophthalmic Dispenser for May, 1950, this article appears to be nothing more than a hearsay document. Its publication did

precede the issue date of the patent by just one month. It was not published prior to the filing date of the patent in suit and consequently could have no bearing upon the validity of the patent. *Petition of Weltzien*, 68 F. Supp. 1000, 10 Fed. Rul. Serv. 1013, 1016:

“It has been held that the affidavit of a party or his attorney as to what a witness will testify to is hearsay and insufficient to support a motion for a new trial. *Collins v. Central Fruit Co. of Rochester*, 135 Misc. 465, 238 N.Y.S. 226.”

As to the affidavit of Dr. Peter C. Kronfeld, this affidavit cannot be reconciled with his statements made in a discussion following the second report on the Tuohy corneal lens delivered at the Thirty-third Annual Meeting of Pacific Coast Ophthalmological Society. A reprint of the second report on the Tuohy corneal lens is included in the plaintiff's scrapbook, Exhibit 7. At page 10 of the report under the heading “Discussion,” Dr. Kronfeld of Chicago, Illinois, made the following statement:

“I haven't tried any of these lenses, but I am impressed with the results presented here today.

“About eighteen years or twenty years ago, we used in our retinal detachment work a forerunner of this lens to keep the cornea clear. I don't remember who devised that lens, but it was made of glass and obtained from Zeiss in Germany. I convinced myself at that time that such a lens could stay with the patient's cornea during the entire operation. Later on we modified our detachment

technique and it became unnecessary to protect the cornea by means of a lens. We learned to hide the cornea under the conjunctival flap or under one lid, upper or lower, whenever possible.

“Just for my own information, I would like very much to know what success has been obtained in patients who really benefit from a contact lens. It doesn’t make so very much difference whether or not a myope of three or four diopters can wear a contact lens. To a person with myopia from 18-25 diopters, however, it means a great deal to see with a contact lens instead of the ordinary minus lens. I would like to know how those people, as well as people with corneal scars, do with the new lens.

“I would also like to hear a more specific statement about the incidence of corneal edema. Apparently it doesn’t happen as often as with regular type contact lenses, but perhaps the statement of Dr. Nugent could be made more specific for my own enlightenment.”

If the Kronfeld lens used by him in his operation work had the same characteristics of being ground to correct for visual deficiency and of being smaller than the limbus but larger than the largest iris opening and had an internal radius of curvature slightly greater than the curvature of the cornea, Kronfeld would not have stated in the discussion following the second report on the Tuohy corneal lens, “I haven’t tried any of these lenses.” Likewise he would not have asked for the additional information which he solicited, as

above quoted, if he had a lens that met the terms of the claims of the patent in suit and had used the lens in a manner contemplated by the patent. He would have had such information available to him and there would have been no occasion for him to ask for it.

It is therefore submitted that the trial court did not abuse its discretion in refusing to grant a new trial. No adequate showing of diligence was made and even the evidence produced in support of the petition for a new trial was not of such a character that it was likely to have brought about a change of decision.

VIII.

**THE TRIAL COURT DID NOT ERR ON THE ISSUE
OF UNFAIR COMPETITION**

In the memorandum opinion (R. 12-13) the Trial Court said:

“I also find in favor of the plaintiff *on the issue of unfair competition*. I do not believe the shortening of the word ‘corneal’ to ‘cornea’ is sufficient. The use of the two words would certainly cause confusion with the general public.”

Appellants contend at pages 20 and 21 of their brief that the words “corneal lens” are descriptive and consequently are incapable of constituting a technical trade-mark. However, whether the word “corneal” constitutes a technical trade-mark or is susceptible of exclusive appropriation, is immaterial insofar as unfair competition is concerned. In *Lane Bryant, Inc. v. Maternity Lane Ltd.*, 173 F. (2d) 559 (C.A. 9) this Court said:

“That the words and phrases used in common by both parties are common expressions in general use is not an absolute defense to charges of unfair trade practice, is well established. The principle is exceptionally well stated in *Banzhaf et al v. Chase*, 150 Cal. 180, 182, wherein the defendant was enjoined from selling bread under the name ‘New Homestead’, the plaintiff having sold bread for many years under the name ‘Old Homestead’: ‘The words “Old Homestead,” or “homestead,”

may, and perhaps do, suggest that the bread on which they appear is asserted to be similar to that made in the ordinary old homestead. . . . But we may concede that the words are descriptive in character and relate to quality, and hence that, under section 991 of the (California) Civil Code, they cannot be appropriated by any person as his own, so as to give him a right to prevent their use by another to his injury, regardless of the motives or purposes of the other in so using them.' See the *Modesto Creamery v. Stanislaus Creamery Co. et al.*, 168 Cal. 289, wherein butter was labeled 'Modesto'."

Nims, Unfair Competition and Trade-Marks, 4th edition, pages 66 and 67:

"The user of trade insignia may not exclude others from employing common words and devices in their usual significance. His legal right is limited to prohibiting their fraudulent use. Yet this limited right, under modern conditions, is of great value.

.

"Nevertheless, unfair competition actions often are distinguished from actions of trade-mark infringement on the grounds that they involve no proprietary interest in the words or devices in question.

"In *Shaver v. Heller*, it was held that suits for infringements of trade-marks rest upon ownership of the trade-marks, whereas suits for unfair competition are founded upon the damage caused by

the fraudulent passing off of the goods of one manufacturer for those of another; that in suits for trade-mark infringement title to the trade-mark is indispensable to a good cause of action, but that in suits for unfair competition 'no proprietary interest in the words, names or means by which the fraud is perpetrated is requisite to maintain a suit to enjoin it. It is sufficient that the complainant is entitled to the custom—the good-will—of a business and that this good-will is injured, or is about to be injured, by the palming off of the goods of another as his.' ”

In the present case the defendant, Morris Green, purchased lenses from the plaintiff Solex (R. 112). The trade names “Tuohy Corneal Lens” or “Corneal Lens” appeared on all of the plaintiff’s packages (R. 110). Defendant, Morris Green, proceeded to advertise the lenses that he purchased from plaintiff, Solex, in the newspapers (R. 112). He was asked to stop but refused to do so. Thereafter, he proceeded to manufacture and place on the market the infringing lenses and advertise the infringing lenses as being new “cornea” lenses, plaintiff’s Ex. 12.

By purchasing the plaintiff’s lenses under the names of “Corneal Lenses” and “Tuohy Corneal Lenses,” advertising them as corneal lenses in endeavoring to re-sell them, then manufacturing the infringing article and advertising the infringing article as the “New Cornea Lens”, the appellants are, in effect, demanding the right to continue to perpetrate a fraud on the public.

While the defendant Green was purchasing the plaintiff's lenses under the names "Corneal Lens" and "Tuohy Corneal Lens" and reselling them to the public, the public was led to believe that they were purchasing the plaintiff's lenses and that the defendant was but a distributor thereof. But when the defendant Green undertook to manufacture his own lenses and to sell them under the name "Cornea Lens" or "New Cornea Lens" he was attempting to take advantage of the good will developed for the plaintiff's lenses. The purchasing public was expected by the defendant Green to assume that the defendant's lenses purchased from him were the same lenses as those which Green had previously been purchasing and reselling and which were of the plaintiff's manufacture. This constitutes unfair competition.

As to jurisdiction of the claim of unfair competition, jurisdiction is conferred under the provisions of Sec. 1338(b) of 28 U.S.C.A. Certainly, the manner in which these defendants-appellants have been infringing the plaintiff's patent is a "substantial and related" claim to the patent infringement issue.

IX.

CONCLUSION

There is no reversible error in this record. Substituted counsel sought to re-litigate this case before the Trial Court. His motion for a new trial was denied (R. 39). Having been thus denied a new trial, he seeks to re-litigate the matter here as if this appeal were a trial *de novo*. The Federal Rules of Civil Procedure, however, require this Court to regard findings of fact of invention and of infringement, reversible only where such findings are clearly erroneous. This is not the situation presented on this record.

It is respectfully submitted that the Lower Court should be affirmed.

Respectfully submitted,

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Attorney for Appellee.

